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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Intelligent Sports Inc.
v.
Randy Buller

Opposition No. 95,834
to application Serial No. 74/461,113
filed on November 22, 1993

R. Terrance Rader, Michael B. Stewart, Cynthia Summerfield,
and Glenn E. Forbis of Rader, Fishman and Grauer for
opposer.

Thomas G. Bailey, Jr., Jorge Areimiega, Michael Okada, and
Bridget McCarthy of Whitman Breed Abott & Morgan for
applicant.

Before Rice, Hohein, and Hairston, Administrative Trademark
Judges.

Opinion by Rice, Administrative Trademark Judge:

An intent-to-use application has been filed by Randy
Buller, an individual, to register the mark PARTS AUTHORITY
(PARTS disclaimed) for retail store services and

distributorship services dealing in automobile parts, supplies and accessories.¹

Registration has been opposed by The Sports Authority, Inc., now by assignment and change of name Intelligent Sports Inc.² As grounds for its opposition, opposer asserts essentially that it is engaged in the business of marketing, through its national chain of retail outlets, "various products and services;"³ that since prior to applicant's filing date, opposer has used the trade name THE SPORTS AUTHORITY, and trademarks formed or dominated by the term

¹ Application Serial No. 74/461,113, filed November 22, 1993 under the provisions of Section 1(b) of the Trademark Act of 1946, 15 U.S.C. §1051(b), based on applicant's assertion of a bona fide intention to use the mark in commerce.

² The record shows that the marks pleaded by the original opposer, The Sports Authority, Inc., were thereafter assigned to TSA, Inc., which changed its name to Intelligent Sports Inc., and that Intelligent Sports Inc. has licensed use of the marks back to The Sports Authority, Inc. In an action dated April 17, 1996, Intelligent Sports Inc. was joined as party plaintiff herein pursuant to a stipulation submitted by the parties. Inasmuch as the discovery and testimony periods have now closed, we hereby substitute Intelligent Sports Inc. for The Sports Authority, Inc. as party plaintiff. See TBMP §512.01. The Trademark Trial and Appeal Board Manual of Procedure (TBMP) (Stock No. 903-022-00000-1) is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402. (Telephone (202) 512-1800). It is also available for a fee from the Patent and Trademark Office's Office of Electronic Information Products in the form of a CD-ROM titled "Trademarks Assist." (Telephone (703) 306-2600). Finally, it is available on the global computer network at <http://www.uspto.gov/web/offices/dcom/ttab/tbmp/>.

³ The notice of opposition fails to identify the types of goods and services marketed by opposer. In order to give an applicant fair notice of the basis for its claim, an opposer asserting Section 2(d) (e.g., likelihood of confusion with a mark registered and/or previously used by opposer) as a ground for opposition should specify in its pleading both the mark or marks

AUTHORITY, including THE SPORTS AUTHORITY, THE KNIFE AUTHORITY, THE BAG AUTHORITY, and THE LOW PRICE AUTHORITY, in connection with its marketing activities; that opposer owns four U.S. trademark registrations for certain of its marks;⁴ that opposer's goods and services provided under its trade name and trademarks have been extensively and continuously marketed and promoted throughout the United States, with resulting widespread recognition of opposer's trade name and trademarks; and that applicant's mark PARTS AUTHORITY, as used in connection with applicant's specified services, so resembles opposer's trade name and trademarks as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant, in his answer to the notice of opposition, has denied the salient allegations contained therein. In addition, applicant has asserted affirmatively that, inter alia, there are numerous marks, registered and unregistered, which incorporate the word AUTHORITY, such that the word lacks the distinctiveness to create a likelihood of confusion between opposer's marks and applicant's mark.

The record consists of the pleadings; the file of the opposed application; status and title copies of seven

relied on and the goods or services in connection with which the mark(s) is/are used.

⁴ The notice of opposition specifies the numbers of the four registrations, but not the marks and goods or services covered thereby; no copies of the registrations were attached to the pleading.

registrations owned by opposer, the discovery deposition (and attached exhibits) taken by opposer of applicant Randy Buller, applicant's responses to opposer's interrogatories 1-59, and copies of two trademark search reports, all listed in opposer's notice of reliance;⁵ and the testimony deposition of Michael Lisi, Vice President, General Counsel, and Secretary of Intelligent Sports Inc., in behalf of opposer. The parties have briefed the case, but did not request an oral hearing.

Opposer's record shows that opposer (except as otherwise indicated, the term "opposer" is used herein to refer collectively to The Sports Authority, Inc. and its

⁵ The trademark search reports were produced by applicant in response to opposer's request for production of documents. A party which has obtained documents from another party pursuant to a request for production of documents may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of Trademark Rule 2.122(e), 37 CFR §2.122(e), which relates to printed publications of general circulation and official records. See Trademark Rule 2.120(j)(3)(ii), 37 CFR §2.120(j)(3)(ii). Inasmuch as the trademark search reports are neither printed publications of general circulation nor official records, they are not admissible by notice of reliance. Moreover, the Board will not consider copies of a search report of information taken from a private company's data base as credible evidence of the existence of the registrations listed therein. In order to make third-party registrations of record, soft copies of the registrations themselves, or the electronic equivalent thereof, i.e., printouts of the registrations taken from the electronic records of the Patent and Trademark Office's own data base, must be submitted. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); *In re Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); and TBMP §703.02(b). However, applicant has not objected to the admission of the search reports but rather has treated them as being of record. Accordingly, we deem the search reports, and the registrations mentioned therein, to be of record by stipulation of the parties.

successor, Intelligent Sports Inc.) was formed in 1987 for the purpose of establishing a chain of category killer sporting goods stores, i.e., large stores (of approximately 40,000 square feet) featuring a wide assortment of sports equipment, from footwear and apparel to hard goods, with everyday low prices and a high degree of service. The first store was opened, under the mark THE SPORTS AUTHORITY, in November 1987 in Ft. Lauderdale, Florida. The chain grew rapidly, and by the time of opposer's testimony period, in March of 1996, opposer had become the world's largest full-line sporting goods retailer, with 131 THE SPORTS AUTHORITY stores located throughout the United States, including New York (where applicant is located). The mark is used on store signs and employee uniforms. In addition, every item of merchandise sold in the store has a hang tag and/or a price sticker bearing the mark.

Opposer's advertising and promotional activities (e.g., print advertising, television and radio advertising, sports sponsorships, and billboards) in connection with THE SPORTS AUTHORITY stores have been quite extensive, with total expenditures amounting to more than \$150 million for the eight-year period running from 1988 through 1995. Opposer's sales under the mark for the same period totaled well over \$3 billion. Moreover, opposer and its stores have been the subject of a large number of unsolicited articles over the

years. In short, the evidence of record indicates that THE SPORTS AUTHORITY has become a very well known mark for opposer's retail store services featuring sporting equipment and clothing.

In connection with its retail sporting goods store services, opposer uses not only its house mark THE SPORTS AUTHORITY, but also other marks comprising or containing the term AUTHORITY, used to identify certain aspects of opposer's services. Examples of these marks include THE SKI AUTHORITY; THE BASKETBALL AUTHORITY; THE GOLF AUTHORITY; THE BAG AUTHORITY; THE KNIFE AUTHORITY; THE SHOE AUTHORITY; and THE FOOTWEAR AUTHORITY.

Opposer's record includes copies of a number of U.S. trademark registrations which it owns. The registered marks are THE SPORTS AUTHORITY⁶ (SPORTS disclaimed) and THE SPORTS AUTHORITY and design⁷ (SPORTS disclaimed), as shown below,

⁶ Reg. No. 1,527,526, issued Feb. 28, 1989 from an application filed June 27, 1988; Section 8 affidavit accepted.

⁷ Reg. No. 1,529,035, issued March 7, 1989 from an application filed June 27, 1988; Section 8 affidavit accepted; Section 15 affidavit received.

THE
SPORTS
AUTHORITY

both for retail store services featuring sporting equipment and clothing; THE SPORTS AUTHORITY (SPORTS disclaimed) for ladies' apparel, namely, shirts, and men's apparel, namely, hats, visors, pants, shirts, shorts and swim trunks;⁸ AUTHORITY for apparel, namely, rainwear, jackets, coats, suits, slacks and vests;⁹ THE SKI AUTHORITY for retail store services featuring ski equipment and clothing;¹⁰ THE LOW PRICE AUTHORITY for retail store services comprising the sale of sporting goods and equipment, footwear and clothing;¹¹ and THE BAG AUTHORITY (BAG disclaimed) for athletic bags, drawstring bags used for sleeping bags and floor mats, duffel bags and soft luggage.¹² In addition,

⁸ Reg. No. 1,821,430, issued Feb. 15, 1994 from an application filed March 1, 1993.

⁹ Reg. No. 1,245,417, issued July 12, 1983 from an application filed May 24, 1982; Section 8 affidavit accepted; Section 15 affidavit received.

¹⁰ Reg. No. 1,688,221, issued May 19, 1992 from an application filed Nov. 19, 1990.

¹¹ Reg. No. 1,937,000, issued Nov. 21, 1995 from an application filed Nov. 4, 1994.

¹² Reg. No. 1,938,392, issued Nov. 28, 1995 from an application filed Nov. 4, 1994.

the record indicates that at the time of its testimony period, opposer owned a large number of pending applications to register marks containing the term AUTHORITY, including THE KNIFE AUTHORITY, THE BICYCLE AUTHORITY, RUNNING AUTHORITY, IN-LINE AUTHORITY, SHOE & APPAREL AUTHORITY, FOOTWEAR AUTHORITY, HOCKEY AUTHORITY, FITNESS AUTHORITY, and others.

During its testimony period, opposer also filed an intent-to-use application to register the mark PARTS AUTHORITY for retail outlets featuring sporting goods and equipment and parts, components and materials for use with the same; rental of sporting goods and protective clothing and equipment. Opposer's witness, Mr. Lisi, testified that from the beginning, opposer has sold parts for skis, firearms, and in-line skates, as well as for equipment for the racket sports, golf, and tennis; that these sales have been "heavy;" that for several years, opposer's senior managers have been discussing the need to put together one area in its stores which would be a tech center or a parts and service center; and that PARTS AUTHORITY is exactly the kind of mark opposer needs and should be using.

Finally, the record shows that in approximately 40 instances, opposer has taken action, ranging from a cease and desist letter to an opposition in the U.S. Patent and Trademark Office to a federal civil action, with respect to

what it considered to be infringing uses of marks containing the term AUTHORITY. Twelve of these, including the present opposition proceeding, were still pending at the time of Mr. Lisi's deposition. The remainder had apparently been resolved in a manner favorable to opposer.¹³

As a result of opposer's discovery efforts, the record contains information concerning applicant and the mark he seeks to register. Applicant is the president of Pro Parts, Inc. (hereafter "Pro Parts"), a corporation formed in 1984. Pro Parts is engaged in the business of selling automobile repair parts to automotive repair shops, dealerships, fleets, etc. The company purchases these parts from manufacturers and sells them (still bearing the manufacturers' marks) to the automotive aftermarket. Pro Parts also sells repair-related equipment such as hydraulic lifts, wheel alignment machines, brake lathes, etc.

Affiliated with Pro Parts are four other companies which, like Pro Parts, are engaged in the distribution of automotive parts. These four companies, i.e., Clearway Automotive, Inc., Clearway Foreign, Inc., Clearway Auto East, Inc., and Accurate Automotive, Inc., are essentially

¹³ We note that opposer, in its brief on the case, has included updated information concerning its policing efforts, the number of stores it has, its applications and registrations, etc. Indeed, opposer's briefs are replete with facts not included in the record. Factual evidence cannot be introduced through a brief. Only those facts which are supported by evidence properly submitted during the testimony periods can be considered in our determination of this case.

owned and run by relatives of applicant. Applicant himself is not an officer or shareholder of any of the four, nor is he affiliated with them. However, the four companies and Pro Parts operate cooperatively. All five companies are located in the state of New York, and do virtually all of their business in that state, although there is some spillover into New Jersey and Connecticut.

According to applicant's discovery responses, the mark PARTS AUTHORITY has been in use since December of 1993. The mark was chosen by applicant, who for some time had been looking for a way to give a common identity to all the companies, while keeping their individual identities intact. Applicant testified that he went into one of opposer's THE SPORTS AUTHORITY stores in 1990 or 1991, and that he thought he was familiar with opposer's mark when he selected the mark PARTS AUTHORITY.

Use of the mark PARTS AUTHORITY is made not by applicant himself but rather by Pro Parts and the four affiliated companies. There is no written agreement between applicant and any of the companies concerning use of the mark. Rather, applicant just told them to use it.¹⁴

¹⁴ Applicant's answers to opposer's interrogatories 1 and 58 state that applicant has orally granted the right to use the mark to yet another company, Parts Authority, Inc., a New York corporation of which applicant is president; that use of the mark has been through this corporation, "the business of which is that of an automotive parts distributor which primarily sells automotive parts manufactured by third parties to auto repair shops and professional mechanics"; that applicant exercises

The five companies do very little advertising, and never advertise in magazines or newspapers or on television or radio. The mark PARTS AUTHORITY is used by the companies in answering the phone,¹⁵ on invoices, on the side of a delivery truck used by Pro Parts, Inc. and Clearway Automotive, Inc., on T-shirts (and possibly also on hats, sweatshirts, and candy) given away by the companies from time to time as promotional items, and on company name and phone number stickers distributed by the companies to their customers for posting near the customers' telephones. The mark was also used on a mailer sent out by Pro Parts, Inc. when it opened a new store in 1994. In addition, the five companies held a trade show on April 25, 1995 and used the PARTS AUTHORITY mark on the trade show invitations, literature, and signage. Finally, during the year preceding the taking of applicant's deposition on October 19, 1995,

control over the quality of services rendered under the mark by way of such agreement and "insofar as Applicant controls" the corporation; and that use of the mark by this company has inured to applicant's benefit. However, applicant stated at his discovery deposition that he didn't know whether he was president of Parts Authority, Inc.; that his grant to that company of the right to use the mark was very informal; that the company has no business activity; that within the two months prior to the deposition, the other companies set up a checking account for Parts Authority, Inc.; and that that company has one or two employees paid out of that account who do work that benefits all of the companies. It is clear from this testimony that Parts Authority, Inc. is a shell corporation which has not yet engaged in any commercial activity and has not made any use of the mark PARTS AUTHORITY in connection with the distribution of automotive parts.

¹⁵ Each company answers the phone with the statement, "Thank you for calling [company name], your parts authority."

Clearway Automotive, Inc. began to stamp the mark PARTS AUTHORITY on some of the parts which it distributes.

Applicant is not aware of any instances of confusion, mistake, or deception as to source arising from applicant's use of the mark PARTS AUTHORITY in connection with retail store services and distributorship services dealing in automotive parts, supplies, and accessories.

The 1995 trademark search report produced by applicant in response to opposer's request for production of documents, and made of record by opposer's notice of reliance (see footnote 5), indicates that a number of marks containing the term AUTHORITY have been registered by third parties.¹⁶

Opposer's priority of use of the marks THE SPORTS AUTHORITY, THE SPORTS AUTHORITY and design, AUTHORITY, and THE SKI AUTHORITY, for the goods and services listed in its

¹⁶ The marks in the third-party registrations include TWO WHEEL TRANSIT AUTHORITY for, inter alia, bicycles, parts, and accessories therefor, shirts, shorts, hats, jackets, shoes, and retail store services in the fields of bicycles, bicycle tools, clothing, and accessories; MOBILE AUTHORITY for automotive stereo equipment; THE TRAVEL AUTHORITY for marketing consulting services rendered to travel agencies; AUDIO AUTHORITY and design for, inter alia, switching and demonstration apparatus used to select, control and compare audio and visual signals to and from electronic entertainment products; THE CRUISE AUTHORITY for services of a travel agency specializing in arranging cruises; THE DSP AUTHORITY for add-on computer circuit boards, computer interface units, and parts for the foregoing; PORT AUTHORITY for microprocessor and electronic switching control devices; AUTHORITY for residential and commercial lock sets; SOUTH JERSEY TRANSPORTATION AUTHORITY for administration and operation of highways, airports and parking lots; HIGHER AUTHORITY

registrations thereof, is established by the evidence of record. Moreover, the issue of priority does not arise in a proceeding such as this against an opposer's registered mark or marks. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Here, opposer has made of record not only its registrations for these four marks but also its registrations for the marks THE BAG AUTHORITY and THE LOW PRICE AUTHORITY. Thus, the issue to be determined herein is the issue of likelihood of confusion, including whether opposer has a family of marks with the AUTHORITY surname.

We turn first to opposer's contention that it owns a family of marks characterized by the term AUTHORITY. The "family" of marks doctrine has applicability in those situations where, prior to a defendant's first use of its challenged mark containing a particular feature, the plaintiff had established a family of marks characterized by that feature, so that the defendant's subsequent use of its mark containing the feature for goods or services which are similar or related to plaintiff's will cause the relevant purchasing public to assume that defendant's mark is yet another member of the plaintiff's family. See *Blansett Pharmaceutical Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992); *Econo-Travel Motor Hotel Corp. v.*

PRODUCTIONS for television show production services; and THE

Econ-O-Tel of America, Inc., 199 USPQ 307 (TTAB 1978); and *Porta-Tool, Inc. v. DND Corp.*, 196 USPQ 643 (TTAB 1977). It is well settled that merely adopting, using, and registering a group of marks having a feature in common for similar or related goods or services is insufficient to establish, as against a defendant, a claim of ownership of a family of marks characterized by the feature. Rather, it must be demonstrated that prior to the defendant's first use of its challenged mark, the various marks said to constitute the plaintiff's family, or at least a good number of them, were used and promoted together in such a manner as to create among purchasers an association of common ownership based upon the family characteristic. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1646 (TTAB 1987); and *Cambridge Filter Corp. v. Servodyne Corp.*, 189 USPQ 99 (TTAB 1975).

In the present case, opposer has made of record a large number of print advertisements in which it has used the mark THE SPORTS AUTHORITY or THE SPORTS AUTHORITY and design with another designation containing the term AUTHORITY, such as GOLF & TENNIS AUTHORITY, BASKETBALL AUTHORITY, TEAM SPORTS AUTHORITY, YOUR OUTERWEAR AUTHORITY, HUNTING AUTHORITY, HOCKEY AUTHORITY, SHOE AND APPAREL AUTHORITY, FOOTWEAR

TIRE AUTHORITY for retail tire store services.

AUTHORITY, and YOUR FITNESS AUTHORITY. This is certainly a type of use which may serve to create a family of marks. However, it appears that virtually all of the advertisements were run in 1994 or 1995, that is, at a date subsequent to the November 22, 1993 filing date of applicant's involved application. Some of the advertisements are in Spanish, having been run in Spanish speaking areas of the United States. There is no translation of these advertisements, so we cannot tell what AUTHORITY designation, if any, may have been used in them in addition to the mark THE SPORTS AUTHORITY (which appears in English in all of the Spanish advertisements). There are two Spanish advertisements which do include, in English, the designation THE SKI AUTHORITY, and which appear to have been run in 1990, in one case, and in 1991, in the other.¹⁷ However, there is no testimony to that effect. Moreover, even if their dates were prior to applicant's November 22, 1993 filing date, these two advertisements alone would be insufficient to prove that opposer had established a family of AUTHORITY marks prior to such date. Because opposer's evidence is insufficient to show that opposer established a family of AUTHORITY marks prior to applicant's filing date, the issue of likelihood of confusion must be determined by comparing applicant's mark

¹⁷ The dates on many of the Spanish advertisements are unclear.

with each of opposer's registered marks considered individually.¹⁸

The most pertinent of opposer's marks is the mark THE SPORTS AUTHORITY, the strongest of opposer's marks by reason of opposer's extensive use and promotion thereof, and the mark to which most of opposer's evidentiary record is devoted. There can be no doubt that THE SPORTS AUTHORITY is very well known as a mark for opposer's retail store services featuring sporting equipment and clothing.¹⁹ However, applicant's mark PARTS AUTHORITY is readily distinguishable from the mark THE SPORTS AUTHORITY in sound, appearance, and meaning. Moreover, opposer has failed to show that the services in connection with which applicant uses his mark, namely, retail store services and distributorship services dealing in automotive parts, supplies and accessories, are related in any meaningful way to opposer's retail store services featuring sporting equipment and clothing.²⁰ Considering the substantial

¹⁸ Of course, opposer is also entitled to rely upon each mark as to which it has proved priority of use. However, there is no evidence of prior use of any of opposer's unregistered marks.

¹⁹ Indeed, applicant concedes, on page 10 of its brief, that the mark THE SPORTS AUTHORITY is a strong mark.

²⁰ We find totally unpersuasive opposer's argument, on page 27 of its main brief, that "Applicant's goods, i.e. automobile replacement parts, are identical to many goods sold by [opposer] such as part [sic] for bicycles, in-line skates, skateboards and other modes of transportation." We also note that the record is devoid of evidence that the automotive parts market is within opposer's area of natural expansion.

differences in both the marks and the services of the parties, we conclude that there is no likelihood of confusion.

Although opposer's registered mark AUTHORITY bears more similarity to applicant's mark PARTS AUTHORITY than does the mark THE SPORTS AUTHORITY, the clothing items for which this mark is registered so differ from applicant's specified services as to preclude likelihood of confusion.

Similarly, applicant's mark and services so differ from the marks and goods or services in opposer's other registrations that there clearly is no likelihood of confusion by reason of their contemporaneous use.²¹

For the foregoing reasons, we conclude that opposer's opposition is not well taken.²²

²¹ In their briefs on the case, opposer and applicant argue over whether there is evidence of third-party use, with opposer contending, correctly, that the third-party registrations are not evidence that the marks shown therein are in actual use, and applicant urging that the record contains not only the third-party registrations but also opposer's own evidence as to third-party uses against which it has taken action. We need not discuss this question, however, because the cumulative differences between the marks and services/goods involved in this case are such that we would find that there is no likelihood of confusion even if there were no evidence of any third-party use of marks containing the term AUTHORITY.

²² In its brief on the case, opposer asserts that applicant has abandoned his mark through naked licensing. However, this issue was not pleaded by opposer as a basis for opposition. Moreover, we conclude that it was not tried with the implied consent of applicant, because the record does not show that applicant was fairly apprised, prior to or during the trial period, that opposer intended to assert this additional ground for opposition. See, in this regard, TBMP §507.03(b), and cases cited therein. In addition, it must be remembered that applicant's application is an intent-to-use application, and

Decision: The opposition is dismissed.

J. E. Rice

G. D. Hohein

P. T. Hairston

Administrative Trademark
Judges, Trademark Trial
and Appeal Board

that no use is required of applicant at this point. However, in the event that applicant ultimately prevails in this proceeding, and subsequently files a statement of use, it is recommended that the Examining Attorney make further inquiry concerning use of the mark to determine whether applicant is, in fact, the owner of the mark and, if use is then being made through the various companies mentioned above, whether such use is controlled by applicant. Also, if use is made through companies whose use assertedly inures to the benefit of applicant, applicant must amend his application to so state. See Trademark Rule 2.38, 37 CFR §2.38.